

### **REMARKS**

Claims 40-51 and 53-56 are pending in the above application. By the above amendment, claim 52 has been cancelled without prejudice, and claim 56 has been added.

The Office Action dated September 13, 2007, has been received and carefully reviewed. Each issue raised in that Office Action is addressed below, and reconsideration and allowance of claims 40-51 and 53-55 is respectfully requested in view of the above amendments and following remarks.

### **REJECTIONS UNDER 35 U.S.C. 112, FIRST PARAGRAPH**

Claim 52 was rejected under 35 U.S.C. 112, first paragraph, as not being supported by the specification as filed. In order to simplify the issues for a possible appeal, by the above amendment, claim 52 has been cancelled without prejudice.

Claim 54 was rejected under 35 U.S.C. 112, first paragraph, as not being supported by the specification as filed. The examiner indicates in the Office Action that the specification does not show receiving additional data “while the application is terminated, but rather after the application is terminated (emphasis added).” Applicant reserves the right to traverse the examiner’s interpretation of the word “while.” However, in order to simplify issues for a possible appeal and advance the prosecution of this application, by the above amendment, Applicant has changed the phrase “while the application is terminated” in claim 54 to “at a time when the application is not running.” The withdrawal of the rejection of claim 54 is respectfully requested in view of the above amendment.

The phrase “after the application is terminated” has been changed in claim 40 to “at a time when the application is not running” as well.

### **REJECTIONS UNDER 35 U.S.C. 102(e)**

Claim 52 is rejected under 35 U.S.C. 102(e) as being anticipated by Shaw. By the above amendment, claim 52 has been cancelled without prejudice.

REJECTIONS UNDER 35 U.S.C. 103(a)

The rejections under 35 U.S.C. 103(a) are based on an interpretation of Shaw that was offered by the examiner during a telephone interview on June 6, 2006, as explained in the “Statement of Substance of Interview” section of Applicant’s September 21, 2006, Amendment. Specifically, the examiner explained that the portion of Shaw’s email application that connects to the internet is being interpreted as corresponding to the “application” recited in the pending claims. No alternate interpretation has been offered by the examiner in the two Office Actions subsequent to the September 21, 2006, reply, and it is believed that this is still the interpretation of Shaw being used by the examiner. It was also indicated during that telephone discussion that Shaw’s PDL data, or information describing Shaw’s advertising information, was being interpreted as corresponding to the “additional data” recited in the claims.

Claim 40 is rejected under 35 U.S.C. 103(a) as being unpatentable over Shaw in view of Granik. Claim 40 recites a method of presenting advertising information that includes steps of storing an application, data to be acted upon by the application and advertising data in computer readable form, displaying an advertisement based on the advertising data, running the application using the data to be acted upon by the application and terminating the application. The method also comprises a step of, at a time when the application is not running, receiving and saving additional data to be operated upon by the application and additional advertising data, displaying an advertisement based on the additional advertising data, and running the application using the additional data to be acted upon by the application.

Shaw discloses an email application that downloads advertisements while connected to the internet and displays these advertisements on a user’s computer even when the user is not connected to the internet. The advertisements are updated when the user reconnects to the internet, to retrieve additional email, for example. Granik teaches that program updates can be obtained when a user is connected to the internet. The Office Action acknowledges that Shaw does not show the receipt of additional data when the application (the program that connects to the internet) is not running. However, the Office Action asserts that one skilled in the art would have been modified Shaw based on Granik to obtain automatic program updates.

It is respectfully submitted that Shaw already teaches that program updates can be

automatically obtained when a user is connected to the internet (column 19, lines 62-65). Because Shaw already possesses this functionality, one skilled in the art would have no reason to look to Granik for the reason stated in the Office Action. A proper reason for modifying Shaw based on Granik has not been provided, and for at least this reason, a prima facie case of obviousness has not been presented.

Moreover, even if a proper reason for modifying Shaw based on Granik were provided, the proposed modification to Shaw is logically impossible. The Office Action is stating that Shaw must download program updates from the internet at a time when “the application” or the program that connects Shaw’s device to the internet, is not running. In other words, Shaw must somehow download program updates when not connected to the internet. The modification being proposed would therefore require that Shaw’s email program be connected to the internet and not connected to the internet at the same time. This is logically impossible, one skilled in the art would have no reason to attempt to modify Shaw in this manner, and claim 40 is submitted to be allowable over Shaw and Granik for this reason as well.

If the rejection of claim 40 based on Shaw and Granik is not withdrawn, it is respectfully requested that the examiner explain 1) why one skilled in the art would look to Granik to provide Shaw with a functionality that Shaw already possesses, and 2) how Shaw can download information when the application (the program that connects to the internet) is not running.

Claims 41-46 depend from claim 40 and are submitted to be allowable for at least the same reasons as claim 40.

Claim 47 is rejected under 35 U.S.C. 103(a) as being unpatentable over Shaw in view of Granik. Claim 47 recites an information processing apparatus that includes, inter alia, a processor for running an application and an information receiving unit for receiving, when the processor is not running the application, additional data to be acted upon by the application. As discussed above in connection with claim 40, since Shaw’s application is the part of the email program that connects to the internet, Shaw cannot receive additional data when the processor is not running the application. Claim 47 is therefore submitted to be allowable over Shaw and Granik for at least the same reasons as claim 40.

Claim 53 is rejected under 35 U.S.C. 103(a) as being unpatentable over Shaw in view of

Granik. Claim 53 recites an information processing apparatus that includes, inter alia, an information storing medium storing an application, a processor for running the application, and an information receiving unit for receiving, when the processor is not running the application, additional data to be acted upon by the application. As discussed above in connection with claim 40, Shaw already receives program updates, and there would therefore be no reason to look to Granik to provide this functionality. Furthermore, because the portion of Shaw's program that connects to the internet is being interpreted as corresponding to the claimed "application," Shaw does not receive additional data when the processor is not running the application, i.e., when the application is not connected to the internet. Claim 53 is submitted to be allowable for at least these reasons.

Claim 54 is rejected under 35 U.S.C. 103(a) as being unpatentable over Shaw in view of Granik. Claim 54 recites a method of presenting advertising information that includes steps of, inter alia, running an application, terminating the application and, at a time when the application is not running, receiving and saving additional data to be acted on by the application and additional advertising data. As discussed above in connection with claim 40, Shaw already receives additional program data when connected to the internet and there is thus no reason to look to Granik to provide this functionality. Moreover, neither Shaw nor Granik receives information when not connected to the internet as would be required under the interpretation of "the application" being used in the Office Action. Claim 54 is therefore submitted to be allowable over Shaw and Granik for at least the same reasons as claim 40.

Claim 55 is rejected under 35 U.S.C. 103(a) as being unpatentable over Shaw and Granik. Claim 55 as amended recites a method of presenting advertising information comprising, inter alia, storing an application, data to be acted upon by the application and advertising data, displaying an advertisement based on the advertising data and running the application using the data to be acted on by the application (where the data acted on by the application is not advertising data). Claim 55 further recites receiving and saving additional data to be acted on by the application and additional advertising data, and provides that a choice is presented between running the application using the data to be acted on by the processor or running the application using the additional data to be acted on by the application (see page 33, lines 12-17). Shaw and

Granik both discuss program patches. However, nothing in either reference suggests that once a program update is received, a user is given a choice as to whether to run the updated program or to run the program without a patch. Claim 55 as amended is submitted to be allowable over the art of record for at least this reason.

New claim 56 depends from claim 55 and is submitted to be allowable for at least the same reasons as claim 55. In addition, claim 56 recites steps of running the program using the data to be acted on by the application after running the program using the additional data to be acted on by the application. Shaw and Granik do not show or suggest this step, and claim 56 is therefore also submitted to be allowable.

#### CONCLUSION

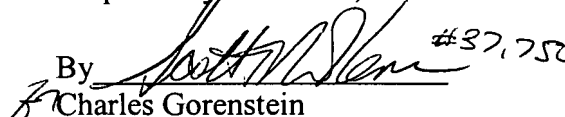
Each issue raised in the Office Action dated September 13, 2007, has been addressed, and it is believed that claims 40-51 and 53-56 are in condition for allowance. Wherefore, reconsideration and allowance of these claims is earnestly solicited.

Should there be any outstanding matters that need to be resolved in the present application, the examiner is respectfully requested to contact Scott Wakeman (Reg. No. 37,750) at the telephone number of the undersigned below, to conduct an interview in an effort to expedite prosecution in connection with the present application.

If necessary, the Commissioner is hereby authorized in this, concurrent, and future replies, to charge payment or credit any overpayment to Deposit Account No. 02-2448 for any additional fees required under 37 C.F.R. §§ 1.16 or 1.14; particularly, extension of time fees.

Dated: October 25, 2007

Respectfully submitted,

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